



AF
2614

PATENT
Attorney Docket N° P1602US00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Brandon A. Grooters
Serial N° : 09/470,537
Filed : December 22, 1999
Group Art Unit : 2614
Examiner : Brian P. Yenke
For : SYSTEM AND METHOD FOR DISPLAYING EVENT RELATED
ELECTRONIC PROGRAM GUIDE DATA ON INTELLIGENT
REMOTE DEVICES

RECEIVED

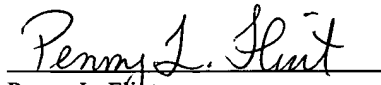
MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAR 03 2004
Technology Center 2600

TRANSMITTAL OF SUPPLEMENTAL APPELLANT'S BRIEF

CERTIFICATE OF MAILING 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service on February 26, 2004, in a First Class envelope, with sufficient postage thereon, addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Penny L. Flint

DATED: February 26, 2004

Please find enclosed herewith three (3) copies of *Supplemental Appellant's Brief*.

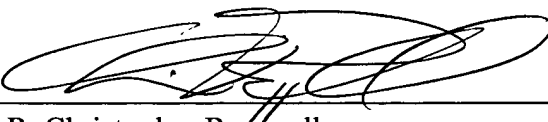
Applicant respectfully requests reinstatement of the appeal filed August 30, 2002. This is a Response, by way of *Supplemental Appellant's Brief*, to the *Office Action* dated December 19, 2003 rejecting Claims 1 through 35.

While it is believed that no fees are due, in the event that the Commissioner determines that any fees are required, the Commissioner is hereby authorized to charge any such fees and to credit any overpayment to Deposit Account N° 50-0439.

Please address all correspondence to: SCOTT C. RICHARDSON, ESQ.
GATEWAY, INC.
LAW DEPARTMENT, MS Y04
610 GATEWAY DRIVE
N. SIOUX CITY, SD 57049-2000
(605) 232-1967 TELEPHONE
(605) 232-2612 FACSIMILE

DATED: February 26, 2004.

Respectfully submitted,
Gateway, Inc.,

By 
R. Christopher Rueppell
Reg. N° 47,045



Appl. No. 09/470,537

In Response to: Office Action Dated December 19, 2003

Title: SYSTEM AND METHOD FOR DISPLAYING EVENT RELATED ELECTRONIC PROGRAM
GUIDE DATA ON INTELLIGENT REMOTE DEVICES

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK EXAMINER

In re application of : Brandon A. Grooters
Serial No. : 09/470,537
Filed : December 22, 1999
Art Unit : 2614
Examiner : Yenke, Brian P.
Title : SYSTEM AND METHOD FOR DISPLAYING EVENT
RELATED ELECTRONIC PROGRAM GUIDE DATA
ON INTELLIGENT REMOTE DEVICES

RECEIVED

MAR 03 2004

Technology Center 2600

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL APPELLANT'S BRIEF

Applicant respectfully requests reinstatement of the appeal filed August 30, 2002. This is a Response, by way of Supplemental Appellant's Brief, to the Office Action dated December 19, 2003 rejecting claims 1 through 35.

(1) REAL PARTY IN INTEREST

Appellant states that the real party in interest is Spotware Technologies, Inc., the assignee of the entire interest. This is verified by the Recordation of Assignment Document, dated March 25, 2000, filed by the Appellant. In the Appellant's Brief on Appeal the real party in interest was incorrectly identified as Gateway, Inc.

(2) RELATED APPEALS AND INTERFERENCES

Appellant's Brief On Appeal, Serial Number 09/470,537, filed on September 4, 2003 is herein incorporated by reference in its entirety.

(3) STATUS OF CLAIMS

The application was filed on December 22, 1999 with twenty-six (26) claims, of which Claims 1, 8, 14, and 21 are independent.

All of the claims were rejected in Examiner's action dated February 15, 2002.

In Appellant's response dated April 15, 2002 independent claims 1, 8, and 14 were amended and arguments were made indicating the patentability of the claims as filed over the proffered references. Additionally, claims 27, 28, 29, and 30 were added, of which claim 27 is an independent claim.

The Examiner made a final rejection of all the claims in the Examiner Action dated July 16, 2002.

The Appellant made arguments in support of patentability on September 16, 2002.

The Examiner in the Advisory Action dated September 30, 2002, indicated that Appellant's arguments were not persuasive, maintaining the rejection of all the claims.

The Appellant filed a Request for Continued Examination (RCE) on October 15, 2002, adding, in an accompanying Preliminary Amendment, new claims 31, 32, 33, 34, and 35, of which claim 31 is an independent claim. Arguments were made indicating the patentability of the claims as filed over the proffered references.

All of the claims were rejected in Examiner's action dated December 4, 2002.

In Appellant's response dated February 5, 2003 independent claims 1, 8, and 14 were amended for the second time, independent claims 21 and 31 were amended, claim 35 was amended, and arguments were made indicating the patentability of the claims as filed over the proffered references.

The Examiner made a final rejection of all the claims in the Examiner Action dated April 8, 2003.

The Appellant made arguments in support of patentability on June 4, 2003.

The Examiner in the Advisory Action dated July 2, 2003, indicated that Appellant's arguments were not persuasive, maintaining the rejection of all the claims.

The Appellant filed a Notice of Appeal on July 8, 2003.

The Appellant filed a Brief On Appeal arguing in support of patentability on September 4, 2003.

The Examiner in the Office Action dated December 19, 2003, indicated that Appellant's arguments on Appeal were not persuasive and the status of the claims is as follows:

Claims allowed: none

Claims objected to: none

Claims rejected: Claims 1-35

(4) STATUS OF AMENDMENTS AFTER FINAL

No amendment to the claims has been submitted.

(5) SUMMARY OF THE INVENTION

In an embodiment of the present invention, a system is provided for displaying program information on a first information handling system 100 and a second information handling system 218 communicatively coupled with one another. The first information handling system 100 is capable of responding to a predetermined event, such as a user input requesting channel change or selection input, by fetching the requested data and transmitting it to the second information handling system 218. The second information handling system 218, when input is received from the user, determines whether the requested data is available in the second information handling system 218. In the event that the data is already available in the second information handling system 218, the second information handling system 218 displays the data. In the event that the data is not available in the second information handling system 218, the second information handling system 218 sends a request for the data to the first information handling system 100.

(6) ISSUES

NEW ISSUES

- (I.) Whether the Examiner has properly reopened prosecution of the instant application by rejecting claims 1-26 under 35 U.S.C. §103(a), as being unpatentable over Darbee et al., U.S. Patent No. 6,130,726 (Darbee), in view of Zigmond et al., US 6,571,392 (Zigmond).
- (II.) Whether the Examiner has properly reopened prosecution of the instant application by maintaining the rejection of Claims 27-35 under 35 U.S.C.

§103(a) as being being unpatentable over Darbee et al., U.S. Patent No.
6,130,726 (Darbee).

PREVIOUSLY-RAISED ISSUES

(III) Whether the Examiner has properly rejected Claims 1-26 under 35 U.S.C.
§ 102(e) as being as being anticipate by Darbee et al., U.S. Patent No.
6,130,726 (Darbee).

(IV) Whether the Examiner has properly rejected Claims 27-35 under 35
U.S.C. § 103(a) as being unpatentable over Darbee et al., U.S. Patent No.
6,130,726 (Darbee).

(7) GROUPING OF CLAIMS

It is the Appellant's intention that the rejected claims be grouped in accordance
with the Examiner's rejections as follows:

Group I should comprise claims 1 through 26 and Group II should comprise
claims 27 through 35. Groups I and II are believed to be separately patentable and the
claims in each grouping do not rise or fall together with the claims of the other groupings
and are separately patentable in accordance with *MPEP 1206*.

(8) ARGUMENT

Group I should comprise claims 1 through 26. For the rejection under §103(a),
Group I should include claims 1-26 because the Examiner relies on the Darbee reference,
in which, the Examiner incorrectly asserted that the reference discloses determining, by
an information handling system, if event related program guide data is present in the
information handling system upon the receipt of an input by the information handling
system, as recited by the present invention. The Examiner correctly states, in the
December 19, 2003 Office Action, that Darbee fails to recite "determining whether event
related program guide data is available in the second information handling system (5),

and the reference is in fact silent as to whether or not local storage is first considered when data is requested.” To correct this defect the Examiner offers the Zigmond reference. However, the Zigmond reference is directed towards a receiver unit and in claim 1 recites, “determining, based on the resource identifier, if the information resource is present in the local storage.” (Zigmond, col. 13, lines 26-27) (Emphasis added). Zigmond provides a receiver unit, which based on information resources it receives from a broadcast communication channel, makes a determination as to the information resources available on the receiver unit based on a resource identifier received from the broadcast communication channel, and makes requests to a packet-switched network when it determines that the information resource which corresponds with the resource identifier is not available. The invention in Zigmond provides this functionality without receiving an input for event related program guide data, as recited by the present invention.

Group II should comprise claims 27 through 35. For the rejection under §103(a), Group II should include claims 27-35 because the Examiner relies on the Darbee reference, in which, the Examiner incorrectly asserts that the reference discloses the displaying of guide data by both the first information handling system and the second information handling system, as recited by the present invention. It is submitted that the limitation of displaying the guide data by both the first information handling system and the second information handling system imparts separate patentability to the claims of Group II from the claims of Group I. Therefore, in accordance with *MPEP 1206*, the claims do not stand or fall together and are separately patentable.

NEW ISSUE I

Whether the Examiner has properly reopened prosecution of the instant application by rejecting Claims 1-26 under 35 U.S.C. § 103(a), as being unpatentable over Darbee et al., U.S. Patent No. 6,130,726 (Darbee), in view of Zigmond et al., US 6,571,392 (Zigmond). With respect to Group I, this grouping should comprise Claims 1-26 because the Examiner relies on the rejection under 35 U.S.C. §103(a) for incorrectly reopening prosecution of the instant application.

Applicant respectfully submits that the Examiner has impermissibly engaged in piecemeal examination of the instant application by raising a §103(a) rejection at this point in the prosecution of the instant application. Accordingly, the rejection is untenable and should be withdrawn.

The Examiner "ordinarily should reject each claim on all valid grounds available." M.P.E.P. §707.07(g). Further, the Examiner's action should be complete as to all matters. 37 C.F.R. 1.104 and M.P.E.P. §707.07(a).

Regarding Issue I, in the instant application the Examiner issued a non-final office action on February 15, 2002. The February 15, 2002 office action did not contain the §103 rejection that is contained in the non-final office action dated December 19, 2003. It is instructive to note that the Examiner indicates review of each reference contained in the Information Disclosure Statement submitted by Applicant and then provides an additional list of references not cited but considered relevant, neither of which contain the Zigmond reference. However, the Darbee reference is cited and Applicant argued for patentability based on Darbee's failure to recite "determining whether event related program guide data is available in the second information handling system (5), and the reference is in fact silent as to whether or not local storage is first considered when data is requested," as the Examiner correctly states in the Office Action of December 19, 2003. Further, the Examiner issued a final office action on July 16, 2002. The July 16, 2002 final office action did not contain the §103 rejection that is contained in the non-final office action dated December 19, 2003. The Examiner maintained the §102 rejection, in view of Darbee, which, based on the reasons stated by the Examiner in the December 19, 2003, was an improper rejection. Further, the Examiner again provided a list of references not cited but considered relevant, which did not contain the Zigmond reference. At this point in the prosecution, the Application should have been moved to allowance.

The Examiner issued an Advisory Action on September 30, 2002, rejecting the arguments of the Applicant. In response the Applicant filed a Request for Continued Examination (RCE) on October 15, 2002. The Examiner issued an Office Action dated December 4, 2002, in which the Examiner made a §102 and a §103 rejection citing the Darbee reference for both rejections. For the reasons which the Examiner states in the

Office Action of December 19, 2003, that Darbee fails to recite "determining whether event related program guide data is available in the second information handling system (5), and the reference is in fact silent as to whether or not local storage is first considered when data is requested," Applicant submits that the §102 and §103 rejections were improper and that the Application should have been moved to allowance at this point. The December 4, 2002 office action did not contain the §103 rejection that is contained in the non-final office action dated December 19, 2003. Again a list of references not cited but considered relevant was provided and again the Zigmond reference, of the December 19, 2003 Office Action, was not cited.

The Examiner issued a Final Office Action dated April 8, 2003, in which the Examiner maintained the §102 and §103 rejections, citing the Darbee reference again. For the reasons which the Examiner states in the Office Action of December 19, 2003, that Darbee fails to recite "determining whether event related program guide data is available in the second information handling system (5), and the reference is in fact silent as to whether or not local storage is first considered when data is requested," Applicant submits that the §102 and §103 rejections were improper and that the Application should have been moved to allowance at this point. The April 8, 2003 office action did not contain the §103 rejection that is contained in the non-final office action dated December 19, 2003. Again a list of references not cited but considered relevant was provided and again the Zigmond reference, of the December 19, 2003 Office Action, was not cited.

The Examiner issued an Advisory Action on July 2, 2003, rejecting the arguments of the Applicant. The Examiner, in the Advisory Action, cited additional prior art references and again the Zigmond reference, of the December 19, 2003 Office Action, was not included in this citation. In response the Applicant filed a Notice of Appeal on July 8, 2003 and an Appeal Brief on September 4, 2003.

The Examiner issued the Office Action dated December 19, 2003, in response to the Appeal Brief filed by the Applicant. For the first time the §103 rejection citing the Zigmond reference was made. The failure of the §102 rejection, citing Darbee, was acknowledged by the Examiner for the reasons stated above, and not included in the December 19, 2003 Office Action.

The §103 rejection raises the issue of obviousness with respect to the claim language contained in claims 1-26 of the instant application. It is submitted that the Examiner, by failing to make this rejection in either the Office Action of February 15, 2002, Final Office Action of July 16, 2002, Office Action of December 4, 2002, or the Final Office Action of April 8, 2003 has engaged in impermissible piecemeal examination of the application.

It is submitted that the Examiner's own statement contained in the December 19, 2003 Office Action, that Darbee fails to recite "determining whether event related program guide data is available in the second information handling system (5), and the reference is in fact silent as to whether or not local storage is first considered when data is requested," establish that the claims are not obvious under 35 U.S.C. §103.

Further, the Zigmond reference does not correct this defect. As stated previously in this Supplemental Brief, the Zigmond reference is directed towards a receiver unit and in claim 1 recites, "determining, based on the resource identifier, if the information resource is present in the local storage." (Zigmond, col. 13, lines 26-27) (Emphasis added). Zigmond provides a receiver unit, which based on information resources it receives from a broadcast communication channel, makes a determination as to the information resources available on the receiver unit based on a resource identifier received from the broadcast communication channel, and makes requests to a packet-switched network when it determines that the information resource which corresponds with the resource identifier is not available. The invention in Zigmond provides this functionality without receiving an input for event related program guide data, as recited by the present invention.

Accordingly, the applicant respectfully requests that the rejection be withdrawn and the appeal reinstated.

NEW ISSUE II

Whether the Examiner has properly reopened prosecution of the instant application by rejecting 27-35 under 35 U.S.C. § 103(a) as being unpatentable over Darbee et al., U.S. Patent No. 6,130,726 (Darbee). With respect to Group II, this grouping should comprise Claims 27-35 because the Examiner has made this rejection in

the Final Office Action of April 8, 2003 and as such it does not provide new grounds for rejection. Therefore, the Examiner cannot rely on this rejection to properly reopen prosecution of the instant application.

Applicant respectfully submits that since the §103 rejection of claims 1-26, citing Darbee in view of Zigmond is impermissible, the rejection of claims 27-35 made under §103, citing Darbee, do not provide the required new grounds for reopening prosecution of the instant application.

“There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* At 1303, 190 USPQ at 427.” (Emphasis added). The 35 U.S.C. §103 rejection made in the December 19, 2003, Office Action does not constitute new grounds for rejection. In the December 19, 2003, Office Action the Examiner asserts the exact same 35 U.S.C. §103 rejection that was made in the April 8, 2003 Office Action. Therefore, the Examiner may not rely on the 35 U.S.C. §103 rejection as new grounds for rejection because the same rejections have been stated in previous office actions. Thus, the Examiner’s actions were impermissible and the appeal should be reinstated.

PREVIOUSLY RAISED ISSUE III

Whether the Examiner has properly rejected Claims 1-26 under 35 U.S.C. § 102(e) as being anticipated by Darbee et al., U.S. Patent No. 6,130,726 (Darbee). Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of anticipation. The Examiner has failed to correctly ascertain and set forth the differences between the claimed invention and the prior art. As stated by the Examiner in the December 19, 2003 Office Action, the Darbee reference fails to recite “determining whether event related program guide data is available in the second information handling system (5), and the reference is in fact silent as to whether or not local storage is first

considered when data is requested.” Accordingly, the rejection is untenable and should be reversed.

Regarding Claims 1-26, and specifically independent Claims 1, 8, 14, and 21, the Examiner rejected these claims under 35 U.S.C. §102(e) as being anticipated by Darbeee. The Appellant respectfully disagrees.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1982) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1984).

Regarding Claims 1, 8, 14 and 21, the Claims include the limitation of “determines whether event related program guide data is available in the second information handling system, and, in the event the event related program guide data is not available, the second information handling system sends a request for the program guide data to the first information handling system.” Thus, the present claimed invention determines whether data is available in the second information handling system (e.g., a remote control device), and if it is not, sends a request to the first information handling system. In contrast, the Darbee reference teaches a remote control 10 that receives information, from a first information handling system (e.g., consumer electronic device), based on the identity of the user. The remote control 10 then takes all the information received and filters/parses out the information according to the users preferences/viewing habits. Further, the remote control 10 is constantly monitoring the user and once the user is identified, the remote control 10 monitors the commands entered from the user in order to retrieve/filter/parse out the appropriate data to be displayed to the respective user. Therefore, the Darbee reference fails to disclose, teach, or suggest determining whether the data is in the second information handling system (e.g., the remote control), and further does not disclose, teach, or suggest requesting the data from a first information handling system after the second information handling system (e.g., remote control) has

determined that the data is not available in the second information handling system, as claimed in the present invention. The Examiner has not shown where such a disclosure, teaching or suggestion for “determining whether event related program guide data is available in the second information handling system, and, in the event the event related program guide data is not available, the second information handling system sends a request for the program guide data to the first information handling system[.]” is contained in the Darbee reference.

For example, in the present invention, if a new user were to utilize a remote and the information required was located in the remote, the remote would not need to access the set-top box as is required in Darbee. In Darbee, a selective download occurs upon the identification of the remote control unit itself, an identification of the user of the remote control or upon some assessment of the viewing habits or preferences of the user and not upon determination if the event related program data is located in the system (remote) itself. Thus, the Darbee reference does not disclose, teach or suggest “determines whether event related program guide data is available” and “in the event that related program guide data is not available, the second information handling system sends a request” as claimed.

In another example of the Darbee invention, suppose for the sake of argument that a second identified user in Darbee required the same information in the remote control as a first previously identified user, and thus, the information was already in the remote. The Darbee reference would still try to obtain the information from the set-top box regardless of the data stored in the remote. However, through use of the present invention, if the information was available in an information handling system, the information handling system would not need to query a set-top box and download the information again as in Darbee. Therefore, it is respectfully submitted that a *prima facie* case of anticipation had not been established, and withdrawal of the rejection is respectfully requested.

Claims 2-7, 9-13, 15-20, and 22-26 are believed to be allowable based on dependence from allowable claims 1, 8, 14, and 21.

PREVIOUSLY RAISED ISSUE IV

Whether the Examiner has properly rejected Claims 27-35 under 35 U.S.C. § 103(a) as being unpatentable over Darbee et al., U.S. Patent No. 6,130,726 (Darbee). Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner has failed to correctly ascertain and set forth the differences between the claimed invention and the prior art. Accordingly, the rejection is untenable and should be reversed.

Regarding Claims 27-35, and specifically independent Claims 27 and 31, the Examiner rejected these claims under 35 U.S.C. §103(a) as being unpatentable over Darbee. The Appellant respectfully disagrees.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). With respect to claim 27, guide data is displayed by both the first information handling system and the second information handling system, which is not taught or suggested by the submitted reference. The Examiner correctly states that "However, Darbee remains silent on [the] being capable of displaying program content and displaying program guide data on the television receiver or set-box (first display)."

The Examiner then asserts various portions of the Darbee reference for support of displaying guide data on a first device. For example, the Examiner first asserts Col. 1, Lines 29-39, which states the following.

Electronic Program Guides (EPGs) or Interactive Program Guides (IPGs) are application which normally run on a screen of a television set or on a set-top box, with the program guide information appearing on the screen of the television. The problem with this approach is that the guide data must either replace or overlay the program that the user is watching, thus interfering with normal program viewing. This is especially a problem when a group of people is watching the television set and only one of them (usually the one with the remote control) wants to access the program guide. *Darbee, Col. 1, Lines 29-39.*

This section teaches the undesirability of showing guide data on a first device. Indeed, Darbee even gives an extensive listing of patents, and then asserts the following.

However, in all instances, the program data is limited to information concerning a particular song or video title that is being or may be broadcast, and there is no suggestion that the program data could or should include graphic program scheduling or advertising data. A typical program message includes, for example, information concerning the composer, track title, the artist and the album associated with the track title. *Darbee, Col. 2, Lines 17-22*

Thus, Darbee suggests that in "all instances", the data is only displayed on the viewing device, because "those skilled in the art failed to fully appreciate the usefulness of a remote control device." *Darbee, Col. 2, Lines 27-29*. To address these problems, Darbee provides data on the remote control unit 10, and NOT the viewing device, i.e., television, and teaches away from displaying data on the viewing device, "without causing an interruption in content that is being depicted on an associated television monitor." *Darbee, Col. 2, Lines 48-49*.

As the Examiner is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Examiner has selected portions from the Darbee reference and the prior art in general to arrive at the present invention, in which, neither Darbee or the prior

art cited by Darbee supply the motivation for combining Darbee and the prior art as proposed by the present invention. Rather, Darbee and the prior art cited by it are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the Darbee reference and the prior art cited by the Darbee reference do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

The presently claimed invention claims displaying the guide data on both the first information handling system and the second information handling system. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *M.P.E.P. 2131.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In the present case, the Examiner's proposed modification to the *Darbee* reference would change the reference in such a way as to be contradictory to the problem it is trying to solve, as stated by the reference itself. The submitted reference, including the submitted portions, fail to teach or suggest the display of guide data on BOTH the first information handling system and the second information handling system. Therefore, it is respectfully submitted that a *prima facie* showing of obviousness has not been established, and withdrawal of the rejection is respectfully requested.

Further, the Examiner is undoubtedly aware, that the combination of "Old" or "Well-Known" Elements to solve different problems renders an invention non-obvious. As stated by the court in *Lindermann Maschinenfabrik BmbH v. American Hoist & Derrick Co.*, 221 USPQ 488, "The '315 patent specifically stated that it disclosed and claimed a combination of features previously used in two separate devices. That fact alone is not fatal to patentability. The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination..." The use of display devices on a first and second information handling system and the content of the display, i.e., electronic programming guide, advertising, and the like, may be known in the art. However, the present invention addresses the need for simultaneous display of that information on the first and a second information handling system. The Darbee reference

addresses the need for the display of information on a remote device to avoid the problem of displaying such information on a second device. The prior art cited by the Darbee reference merely states a solution to displaying information, i.e., an electronic program guide, and the like, on a single device. Nowhere in Darbee or the prior art cited by Darbee is it taught or suggested that the simultaneous display of information as provided by the present invention is desired. In fact, as stated above, the Darbee reference teaches away from the simultaneous display of the present invention. Therefore, Applicant respectfully requests withdrawal of the rejection.

The Examiner states that it would have been obvious to one of ordinary skill in the art to utilize a conventional television display in combination with the Darbee remote device in order to provide the present invention. As the Examiner is well aware, Applicant is required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with Applicant's duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting the position that it would have been obvious to utilize a conventional television display and the remote device in accordance with the claimed invention. If the Examiner is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Further, regarding Claims 31-35, the Claims pertain to a method of displaying data on a first information handling system and a second information handling system, which is not disclosed, taught or suggested by the references. Therefore, the Applicant respectfully requests that the rejection be withdrawn and the claims allowed.

(9) CONCLUSION

For the above reasons, it is respectfully requested that the rejections discussed under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) be withdrawn and the claims allowed.

Respectfully submitted,
Brandon A. Grooters
Spotware Technologies, Inc.

Dated: February 26, 2004

By: 

R. Christopher Rueppell
Reg. No. 47,045

R. Christopher Rueppell
SUITER • WEST PC LLO
14301 FNB Parkway, Suite 220
Omaha, NE 68154
(402) 496-0300 telephone
(402) 496-0333 facsimile

CLAIMS

1. A system for displaying program information comprising:
 - a first information handling system capable of being coupled to a first display;
 - a second information handling system capable of being communicatively coupled with said first information handling system, and having a second display disposed on a housing thereof;
 - said first information handling system being capable of displaying program content on said first display;
 - said first information handling system being capable of responding to a predetermined event by communicating event related program guide data to said second information handling system; and
 - said second information handling system being capable of displaying event related program guide data on said second display, wherein said second information handling system receives an input for event related program guide data, the second information handling system determines whether event related program guide data is available in the second information handling system, and, in the event the event related program guide data is available, the second information handling system displays the program guide data, and, in the event the event related program guide data is not available, the second information handling system sends a request for the program guide data to the first information handling system.
2. The system as claimed in claim 1, wherein said first information handling system comprises a first transceiver and said second information handling system comprises a second transceiver, said first information handling system being capable of transmitting event related program guide data to said second information handling system via said first transceiver to said second transceiver.
3. The system as claimed in claim 1, wherein said first information handling system comprises a first infrared transceiver and said second information handling system comprises a second infrared transceiver, said first information handling system being

capable of transmitting event related program guide data to said second information handling system via said first infrared transceiver to said second infrared transceiver.

4. The system as claimed in claim 1, wherein said first information handling system comprises a first radio-frequency transceiver and said second information handling system comprises a second radio-frequency transceiver, said first information handling system being capable of transmitting event related program guide data to said second information handling system via said first radio-frequency transceiver to said second radio-frequency transceiver.

5. The system as claimed in claim 1, said second information handling system further comprises a selector for allowing a user to browse the event related program guide data via actuation of said selector.

6. The system as claimed in claim 1, wherein:

said first information handling system is capable of displaying program content of a first channel:

said second information handling system further comprises an actuator for allowing a user to browse event related program guide data via actuation of said actuator; and

said event related program guide data is capable of enabling a user to browse programming information relating to program content on the first channel over a predetermined range of time.

7. The system as claimed in claim 1, wherein:

said first information handling system is capable of displaying program content of a first channel:

said second information handling system further comprises a selector for allowing a user to browse event related program guide data via actuation of said selector; and

said event related program guide data is capable of enabling a user to browse programming information relating to program content on a predetermined number of other channels.

8. A system for displaying program content and program guide data, comprising:
means for receiving program content and program guide data;
first means, coupled with said receiving means, for displaying the program content;
means for obtaining program guide data related to an event from said receiving means in response to the event; and
second means, coupled with said obtaining means, for displaying the event related program guide data obtained from said receiving means, wherein an input for event related program guide data is received and a determination made as to whether program guide data is available to the second means, and, in the event the event related program guide data is available, the second information handling system displays the program guide data, and, in the event the event related program guide data is not available, the obtaining means sends a request for the program guide data.
9. The system as claimed in claim 8, said receiving means and said obtaining means including means for wirelessly transmitting the event related program guide data from said receiving means to said obtaining means.
10. The system as claimed in claim 8, said receiving means and said obtaining means including means for transmitting the event related program guide data from said receiving means to said obtaining means via an infrared signal.
11. The system as claimed in claim 8, said receiving means and said obtaining means including means for transmitting the event related program guide data from said receiving means to said obtaining means via a radio-frequency signal.

12. The system as claimed in claim 8, said obtaining means having means for causing said receiving means to transmit the event related program guide data to said obtaining means upon an actuation of said causing means.
13. The system as claimed in claim 8, said obtaining means having means for causing said second display means to display undisplayed event related program guide data upon actuation of said causing means.
14. A method for displaying program guide data, comprising:
receiving an input for event related program guide data;
determining whether the event related program guide data is available in a remote device, and, in the event the event related program guide data is available, the remote device displays the program guide data, and, in the event the event related program guide data is not available;
sending a request for program guide data to a host device, whereby the event related program guide data requested corresponds to the received input;
upon receiving the request, fetching event related program guide data;
transmitting the event related program guide data to a remote device; and
upon receiving the event related program guide data, displaying at least a portion of the event related program guide data on a first display of the remote device such that event related program guide data may be viewed independently from program content.
15. A method as claimed in claim 14, said sending step being executed upon receiving an input into the remote device.
16. A method as claimed in claim 14, the event related program guide data being related to program content displayed on a second display device coupled to the host device.
17. A method as claimed in claim 14, wherein the event related program guide data may be browsed on the remote device by a user.

18. A method as claimed in claim 14, further comprising the steps of receiving an input for event related program guide data, determining whether the event related program guide data is available in the remote device, and, in the event the event related program guide data is not available, executing said sending step whereby the event related program guide data requested corresponds to the received input.

19. A method as claimed in claim 14, wherein the fetched event related program guide data corresponds to programming information over a predetermined period of time for the channel tuned to by the host device, the program content of the tuned channel capable of being displayed on a second display coupled to the host device.

20. A method as claimed in claim 14, wherein the fetched event related program guide data corresponds to programming information for channels other than the channel tuned to by the host device, the program content of the tuned channel being displayed on a second display coupled to the host device.

21. A program of instruction storable on a computer readable medium capable of causing an information handling system to execute steps for displaying program guide data, the steps comprising:

upon occurrence of an event, receiving an input for causing an information handling system to determine whether event related program guide data is available in a remote device, and, in the event the event related program guide data is available, the information handling system does not fetch the event related program guide data from a database, and, in the event that the event related program guide data is not available to fetch event related program guide data from the database;

transmitting the event related program guide data from the information handling system to a remote device via a communications link between the information handling system and the remote device;

storing the transmitted event related program guide data in a memory of the remote device; and

displaying at least a portion of the event related program guide data stored in the memory on a first display disposed on a housing of the remote device.

22. The program of instructions as claimed in claim 21, wherein an undisplayed portion of the event related program guide data stored in the memory of the remote device is caused to be displayed on the first display of the remote device by actuation of an actuator disposed on the housing of the remote device.

23. The program of instructions as claimed in claim 21, wherein the event related program guide data is periodically obtained from the information handling system.

24. The program of instructions as claimed in claim 21, wherein the event related program guide data includes programming information for a predetermined interval of time.

25. The program of instructions as claimed in claim 21, wherein the fetched event related program guide data is related to the received input.

26. The program of instructions as claimed in claim 21, wherein a user may browse event related program guide data on the first display of the remote device while minimally interfering with the viewability of program content displayed on a second display coupled to the information handling system.

27. A system for displaying program information comprising:
a first information handling system coupled to a first display;
a second information handling system capable of being communicatively coupled with said first information handling system, and having a second display disposed on a housing thereof;
said first information handling system being capable of displaying program content on said first display, said first information handling system displaying electronic program guide data on said first display; and

said second information handling system displaying event related program guide data on said second display, wherein said event related program guide data on said second display corresponds to said electronic program guide data displayed on said first display of said first information handling system.

28. The system as claimed in claim 27, wherein said first display includes a display of content and the display of electronic program guide data simultaneously.

29. The system as claimed in claim 28, wherein the electronic program guide displayed on said first display of said first information handling system is displayed in at least one of a minimally invasive and minimally interfering manner.

30. The system as claimed in claim 28, wherein the electronic program guide displayed on said first display of said first information handling system is displayed in a portion smaller than said display of content.

31. A method for displaying program information comprising:

upon occurrence of an event, sending a request for program guide data to a second information handling system from a first information handling system;

upon receiving the request, fetching event related program guide data;

transmitting the event related program guide data to the first information handling system; and

upon receiving the event related program guide data, displaying at least a portion of the event related program guide data on a first display of the first information handling system, wherein said event related program guide data on said first display corresponds to electronic program guide data displayed on a second display of said second information handling system.

32. The method as claimed in claim 31, wherein said first display includes a display of content and the display of electronic program guide data simultaneously.

33. The method as claimed in claim 32, wherein the electronic program guide displayed on said first display of said first information handling system is displayed in at least one of a minimally invasive and minimally interfering manner.

34. The method as claimed in claim 32, wherein the electronic program guide displayed on said first display of said first information handling system is displayed in a portion smaller than said display of content.

35. The method as claimed in claim 31, further comprising determining whether the event related program guide data is available in the first information handling system, and in the event the event related program guide data is not available, executing said sending step.